

Appl. No. 10/764,190  
Docket No. 9495  
Amdt. dated August 18, 2009  
Reply to Office Action mailed on March 18, 2009  
Customer No. 27752

## REMARKS

### Claim Status

Claims 1, 4-12, and 17-19 are pending in the present application. No additional claims fee is believed to be due.

Claims 2, 3 and 13-16 were previously canceled without prejudice.

Claim 1 is amended herein.

Claim 19 is new.

Support for the amendments to Claim 1 and for new Claim 19 may be found in the specification at, *inter alia*, page 1, line 18 – page 2, line 2; page 3, lines 18-21, page 4, lines 5-11, and Figs. 2-4 and 6.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

### Rejection Under 35 USC §112, Second Paragraph

Claims 1, 4-12, 17 and 18 stand rejected under 35 U.S.C. §112, second paragraph, as failing to set forth the subject matter which applicant regards as his invention.

Applicant has amended Claim 1 herein. Applicant believes that the amendment resolves the rejection. Reconsideration and withdrawal of the rejection are respectfully requested.

### Rejections Under 35 USC §103(a)

Under MPEP §2142, the Office bears the burden of factually supporting an asserted *prima facie* conclusion of obviousness. In determining the differences between the cited art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *See, e.g., Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537; 218 U.S.P.Q.

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871 (Fed. Cir. 1983). If the Office does not demonstrate *prima facie* unpatentability, then without more, the Applicant is entitled to the grant of the patent. *See In re Oetiker*, 977 F.2d 1443, 1445; 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992).

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Office must show that all of the claim elements are taught or suggested in the prior art. *See, e.g., CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342; 68 U.S.P.Q.2d 1940 (Fed. Cir. 2003).

Additionally,

a patent [claim] composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

*KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 U.S.P.Q.2D 1385 (2007).

Although the Supreme Court in *KSR* rejected rigid application of a rule requiring demonstration of a teaching, motivation or suggestion within prior art references to combine them as a basis for a conclusion of obviousness, it did not abrogate the requirement. Rather, recognizing that the TSM requirement captured a “helpful insight,” the Court suggested its approval of the TSM analysis within a flexible approach. *See id.* at 1741, 1743. Accordingly, the Federal Circuit has subsequently stated:

[A] flexible TSM test remains the primary guarantor against a non-statutory hindsight analysis . . . . *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“[A]s the Supreme Court suggests, a flexible approach to the TSM test prevents hindsight and focuses on evidence before the time of invention.”). The TSM test, flexibly applied, merely assures that the obviousness test proceeds on the basis of evidence—teachings, suggestions (a tellingly broad term), or motivations (an equally broad term)—that arise before the time of invention as the statute requires.

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As KSR requires, those teachings, suggestions, or motivations need not always be written references but may be found within the knowledge and creativity of ordinarily skilled artisans.

*Ortho-McNeil Pharmaceutical, Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 1364-1365; 86 U.S.P.Q.2D 1196 (Fed. Cir. 2008) (judgment of nonobviousness and infringement affirmed).

Thus, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1372-1373, 85 U.S.P.Q.2D 1641 (Fed. Cir. 2008) (affirming district court's rejection of defendant's obviousness defense), *quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006); *see also KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 U.S.P.Q.2D 1385 (2007) ("To facilitate review, this analysis should be made explicit.")

"[K]nowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references to reach the particular claimed method." *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1372-1373, 85 U.S.P.Q.2D 1641 (Fed. Cir. 2008) (affirming district court's rejection of defendant's obviousness defense). A generalized motivation to improve upon prior art is not the kind of motivation required by the patent laws for proof of obviousness. *See id.*

The lack of evidence of a motivation to combine is a critical defect in an obviousness conclusion, because there must be some suggestion, motivation, or teaching in the prior art whereby the person of ordinary skill would have selected the components that the inventor selected and use them to make the new device. *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1336; 69 U.S.P.Q.2d 1481, 1488 (Fed. Cir. 2004).

Niece in view of Harris – Claims 1, 4, 5, 7-9, 11, 12, 17 and 18

Claims 1, 4, 5, 7-9, 11, 12, 17 and 18 stand rejected under 35 USC §103(a) as unpatentable over Niece (USPN 4,023,682) in view of Harris (USPN 4,143,845).

Applicant respectfully submits that Niece and Harris do not support a *prima facie* conclusion of obviousness of the invention as claimed. There is no teaching, suggestion or motivation apparent or identified that would lead a person of ordinary skill in the art to combine these references.

As amended, Claim 1 recites a shelf display apparatus comprising, *inter alia*: a first vertical support member; a second vertical support member, and a lateral support member having a length, said length joining and resting downwardly upon and vertically compressing said first and second vertical support members, and a nonlinear portion along the length, said nonlinear portion having a plurality of horizontally extending portions that at least partially extend along one or more horizontal directions. By dependency, Claims 4, 5, 7-9, 11, 12, 17 and 18 include these elements.

Niece lacks the lateral support member as recited in Claim 1. Harris does not disclose such a lateral support in the recited configuration. Rather, Harris discloses a “serpentine section 86” that hangs from two hanging “shanks” (*i.e.*, places them in tension, not compression); and the Harris “serpentine section” functions as a shelf-like member, or as underlying support for a shelf. (Harris, Col. 5, lines 41-45.)

Thus, in order to combine Harris with Niece to arrive at Applicant’s claimed invention, it is necessary to separate the “serpentine portion 86” of Harris from the other components from which it hangs, place it into a new and different structural relationship resting upon the “lower end portions 14” of Niece, and assign it a new and different function, which is not described in either of the references as served by the “horizontal portion 12” of Niece or the “serpentine portion 86” of Harris.

There is no teaching, suggestion or motivation in Niece or Harris, or otherwise identified, that would lead a person of ordinary skill in the art to combine these references and rearrange structure and function in this fashion. The problem addressed by Applicant in the instant application is that of the need to hold soft rectangular packages, having major surfaces, in an upright-standing position such that their major surfaces are displayed. (*See* Applicant’s specification at page 1, line 18 – page 2, line 2.) Niece does

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not mention such a problem, nor does it mention or suggest any need for modifying its “horizontal portion 12” for any such purpose. Harris does not mention Applicant’s problem, nor does Harris mention or suggest any possibility of putting its “serpentine section 86” to any use other than the one described and depicted therein.

At page 4 of the Office Action dated 3/18/09, it is suggested that a person of ordinary skill in the art would be motivated to substitute the “serpentine section 86” of Harris for the “horizontal portion 12” of Niece for purposes of providing “aesthetically pleasing alternatively shaped shelving support.” Applicant respectfully submits that this is not an appropriate or sufficient identification of motivation for a combination of the references, to support a *prima facie* conclusion of obviousness.

First, such a motivation is not apparent from the references themselves. Neither Niece nor Harris mention ornamentation or aesthetics as a purpose for their respective features. Niece discloses a retaining device for refrigeration shelves. It is silent concerning any need aesthetic enhancements. Harris describes its “serpentine portion 86” in purely functional terms; there is no mention that its configuration is present for ornamentation or aesthetic reasons.

It has not been shown that such motivation is present elsewhere in relevant prior art. Even if such a generalized motivation may exist, however, what may be aesthetically pleasing is a subjective matter. What features may make an article of the nature of the Niece device aesthetically pleasing to any particular individual is not readily identifiable. For that reason, there is no particular motivation to combine Harris with Niece at the required location for aesthetic purposes, any more than there is a motivation to modify Niece in any infinite number of other ways for aesthetic purposes. The Office has not cited authority that supports the proposition that aesthetics or ornamentation is a recognized motivation for combining particular *utilitarian* features of particular prior art references.

For the foregoing reasons, Applicant respectfully submits that Niece and Harris do not support a *prima facie* conclusion of obviousness of Applicant’s Claim 1 as amended,

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nor the claims that depend from it. Applicant, therefore, respectfully requests reconsideration and withdrawal of the rejection.

Niece in view of Harris, further in view of Heroy – Claims 6 and 10

As discussed above, Applicant submits that independent Claim 1 is patentable over the prior art cited. If Claim 1 is patentable, it follows that dependent Claims 6 and 10, being narrower in scope, are patentable as well. Without waiving any arguments he may otherwise have, Applicant, therefore, defers argument concerning Claims 6 and 10 at this time.

Patentability of New Claim 19

New Claim 19 includes elements, discussed above, that for relevant purposes are similar to those in Claim 1 as herein amended. For that reason, Applicants submit that new Claim 19 is patentable over the prior art cited.

Further, new Claim 19 includes additional elements of a store display, which are not taught or suggested in the prior art of record. Those elements include at least one package containing articles, the package being disposed between lateral support members, being formed of flexible film and being substantially rectangular in shape, having a pair of substantially opposite major surfaces and first and second pairs of substantially opposite lesser surfaces, one of said first pair of lesser surfaces resting on said shelf, and each of said second pair of lesser surfaces respectively contacting one of said respective facing lateral support members, wherein the lateral support members provide horizontal, two-dimensional support to the package such that the package is held in a substantially upright position on a shelf with said major surfaces oriented substantially vertically relative to said horizontal plane. Applicant respectfully submits that the presence of these additional elements in new Claim 19 renders it patentable over the prior art cited.

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Conclusion

This response represents an earnest effort to place the present application in proper form for allowance. In view of the foregoing, entry of the amendments presented herein, reconsideration of this application, and allowance of the pending claim(s) are respectfully requested.

Respectfully submitted,

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